

Amendment under 37 C.F.R. § 1.111
U.S. Application No.: 10/635,486

Attorney Docket No.: FSF-031421

REMARKS

Claim 1 has been amended to include the limitation described in claim 7, claim 7 has been canceled, and claim 21 has been added. Support for the amendment is found, for example, on p. 9, lines 19 to 20 and p. 13. Accordingly, no new matter is presented. Upon entry of the amendment, claims 1 to 6 and 8 to 21 will be pending in the application.

I. Response to Claim Rejection under 35 U.S.C. § 102 and §103

A. Kawahara et al. (US Patent No. 6,436,626)

Claims 1-6 and 18-20 were rejected under 35 U.S.C. § 102 (b) or § 103 (a) as being unpatentable over Kawahara et al.

Applicants respectfully submit that Kawahara et al. does not disclose the photothermographic material of the presently claimed invention. The limitation described in original claim 7 has been incorporated into claim 1. Since claim 7 was not rejected, Applicant respectfully submits the rejection has been overcome.

The patentability of new claim 21 is supported by the following additional reasons. As described in the paragraph bridging pp. 12 and 13 of the specification of the present application, "The present inventor found that when the coating amount of the silver halide having a high silver iodide content which is preferably used in the invention was large, the development was markedly suppressed leading to lowered sensitization, accompanied by deterioration of density stability depending on the development time, which is not preferred... On the contrary, it was found that when the amount to be added is limited, sufficient development property could be achieved even though silver iodide was used." The advantages obtained by using a silver

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U.S. Application No.: 10/635,486

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halide having a high iodide content and a specific average particle size in a reduced amount are clarified in the enclosed Declaration. Kawahara et al. does not teach or suggest such advantages obtained by limiting the coating amount of the silver halide. In addition, the silver halide used in the Examples of Kawahara has a silver iodide content of as low as 2 mol% (column 14, line 33) and an average particle size of 68 nm (column 14, line 43), which are outside the scope of claim 21 of the present application.

Since Kawahara does not teach or suggest the use of a silver halide having a high silver iodide content and a particular average particle diameter in a restricted amount, nor the advantages achieved by the use of such a silver halide, the invention described in claim 21 is novel and unobvious over Kawahara et al.

II. Response to Claim Rejections Under 35 U.S.C. § 103

A. Kawahara et al. in view of Uytterhoeven et al., Siga et al., Ohzeki et al., Fukui et al., or Yoshioka

Claims 18-20 were rejected under 35 § 103 (a) as being unpatentable over the combination of Kawahara et al. and Uytterhoeven et al., Siga et al., Ohzeki et al., Fukui et al., or Yoshioka.

As described above, the limitation described in original claim 7 has been incorporated into claim 1. Since claim 7 was not rejected, amended claim 1 is novel and unobvious over the combination of the cited references. Since claims 18-20 depend from claim 1, Applicant respectfully submits the rejection has been overcome because of their dependency.

B. Kawahara et al. in view of Ikienoue et al. or Tsuzuki

Claims 3-6 were rejected under 35 U.S.C. § 103 (a) as being

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U.S. Application No.: 10/635,486

Attorney Docket No.: FSF-031421

unpatentable over the combination of Kawahara et al. and Ikenoue et al. or Tsuzuki.

As described above, the limitation described in original claim 7 has been incorporated into claim 1. Since claim 7 was not rejected, amended claim 1 is novel and unobvious over the combination of the cited references. Since claims 3-6 depend from claim 1, Applicant respectfully submits the rejection has been overcome because of their dependency.

C. Kawahara et al. in view of Arai et al.

Claims 10-17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Kawahara et al. and Arai et al.

As described above, the limitation described in original claim 7 has been incorporated into claim 1. Since claim 7 was not rejected, amended claim 1 is novel and unobvious over the combination of the cited references. Since claims 10-17 depend from claim 1 directly or indirectly, Applicant respectfully submits the rejection has been overcome because of their dependency.

D. Kawahara et al. in view of Goto et al. or Farid et al.

Claims 8-9 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Kawahara et al. and Goto et al. or Farid et al.

As described above, the limitation described in original claim 7 has been incorporated into claim 1. Since claim 7 was not rejected, amended claim 1 is novel and unobvious over the combination of the cited references. Since claims 8-9 depend from claim 1 directly or indirectly, Applicant

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U.S. Application No.: 10/635,486

Attorney Docket No.: FSF-031421

respectfully submits the rejection has been overcome because of their dependency.

In view of the foregoing amendments and remarks, it is submitted that all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,



TAIYO, NAKAJIMA & KATO
Telephone: (703)838-8013
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Margaret A. Burke
Registration No. 34, 474